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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/661,305	09/13/2000	Takaaki Sato	P19977	7747

7055 7590 07/03/2002

GREENBLUM & BERNSTEIN, P.L.C.  
1941 ROLAND CLARKE PLACE  
RESTON, VA 20191

EXAMINER

DAVIS, NATALIE A

ART UNIT PAPER NUMBER

1642

DATE MAILED: 07/03/2002

13

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/661,305

Applicant(s)

SATO ET AL.

Examiner

Natalie A. Davis

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 April 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Applicant's amendment filed 24 April 2002 (Paper No: 11) is acknowledged. Accordingly, claim 4 is amended, claim 7 is new, and claims 1-7 are pending and under examination.

#### ***Response to Arguments***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Claim Rejections - 35 USC § 101 Withdrawn***

1. Rejection of claims 1-6 under 35 U.S.C. 101 is withdrawn in view of arguments. However, the rejection under 35 U.S.C.112, first paragraph is maintained as indicated below.

#### ***Claim Rejections - 35 USC § 112 1<sup>st</sup> Maintained***

2. Rejection of claims 1-6 and new claim 7 under 35 U.S.C.112, first paragraph is maintained for reasons set forth in the previous office action. The traversal is on the grounds that the submitted supplemental IDS discloses the relationship between NADE and the apoptosis signal transfer pathway via p75NTR, apoptosis is involved in nervous system diseases, wherein the apoptosis signal is transferred from p75NTR and to NADE. Furthermore, that a protein which binds to NADE would be a candidate for diagnosing, treating, and/or preventing diseases involving apoptosis. Applicant's arguments and references have been considered but are not persuasive as to how the claimed agent may be used to prevent apoptosis related diseases. Yaar, et al., (1997, J. Clin. Invest. 100(9):2333-40) suggest that proteins which bind to p75NTR may be used in the treatment of Alzheimer's disease, Franburg-Smith, et al. (2001, Human Pathology, 32(9):976-83) and Descamps, et al, (2001, Cancer Research, 61:4337-40) teach a correlation between p75 expression and disease. Thus, the art indicates that agents may be used to screen for medicaments for the treatment and diagnosis of disease. However, there is no teaching in the art or specification supporting the prevention of disease. Those of skill in the art recognize that,

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although a method may be useful in the treatment of a disease, clinical correlation with prevention of a disease does not necessarily follow. For example, there are methods of treatment for HIV, but there is no method available that protects against infection with HIV. Therefore, in view of the lack of working examples, it would be unpredictable and would require undue experimentation to one skilled in the art to practice the invention as claimed.

***Claim Rejections - 35 USC § 112 2<sup>nd</sup> Withdrawn***

3. Rejection of claims 3-4 under 35 U.S.C.112, second paragraph is withdrawn in view of arguments and amendments.

***Claim Rejections - 35 USC § 112 1<sup>st</sup> Withdrawn***

4. Rejection of claims 1-6 (paragraphs 8-13) under 35 U.S.C.112, first paragraph is withdrawn in view of arguments.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire THREE MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Davis whose telephone number is 703-308-6410. The examiner can normally be reached on M-F 8-5:30 (every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa PhD can be reached on 703-308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4315 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

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Natalie Davis, PhD

June 18, 2002

↑  
ANTHONY C. CAPUTA  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600